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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,046

06/15/2006

Keiji Kubo

8279.1128USWO

7165

52835 7590 01/13/2009

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EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

01/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,046

Applicant(s)

KUBO ET AL.

Examiner

YONG CHU

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 24-26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 19 and 30 is/are rejected.
- 7) ☒ Claim(s) 2-17, 19 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

The certified copy of the foreign priority application submitted on 09/26/2008 has been considered. Claims 20-23 and 27-29 have been canceled by the amendment on 09/26/2008. Claim 1 has been amended. Claims 1-19, 24-26 and 30 are pending. Claims 24-26 remain withdrawn as non-elected subject matter. Therefore, claims 1-19 and 30 are under examination on the merits.

Response to Amendment

The amendment by Applicants' representative Douglas P. Mueller dated on 09/26/2008 has been entered.

Response to Arguments/Remarks

Rejection under 35 U.S.C. §112, 2nd paragraph

Applicants have canceled the rejected claim 23. Therefore, the rejection is moot.

Rejection under 35 U.S.C. §102(e)/103a

Applicant's submission of the certified copy of the foreign priority application of Japan 2003-420031 has antedated the cited prior art. The rejections under 35 U.S.C. §102/103 have been withdrawn accordingly.

Claim Objections

Since the amendment has overcome the cited art rejection, search and examination have been expanded to previously non-elected subject matter. Therefore, the objection is moot. A new prior art has been found, which anticipates the expanded scope of subject matter as disclosed follow:

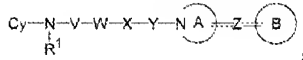
Claim Rejections - 35 USC § 102

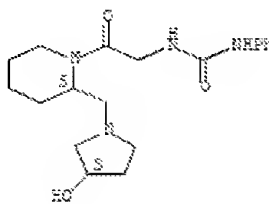
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:


A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15, 17, 19 and 30 are rejected under 35 U.S.C. 102 (e) as being anticipated by Dolle et al., *US2005-01007355 (now U.S. Patent No. 7,160,902)*.

Applicants' claims relate to a compound of the formula (I) , according to claim 1, a prodrug, or a pharmaceutical composition composing a compound thereof.



Dolle et al. disclosed a compound  (CAS RN 851680-59-6) as Compound 36 at line 30, Column 40 for a pharmaceutical application. This compound anticipates the instant claims 1-15, 17, 19 and 30.

Claim Rejections - 35 USC § 112

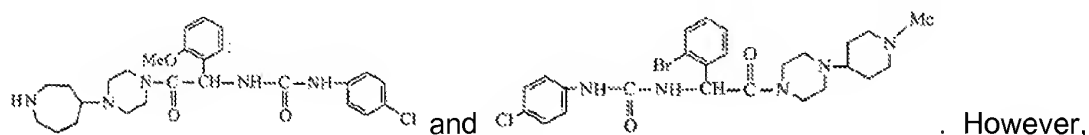
The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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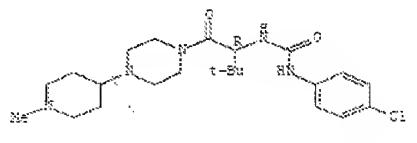
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amended claim 1 excludes two species



these two compounds are not described in the original Specification. The closest

compound disclosed in the instant Specification is



which is patentably distinct from the instantly excluded compounds at the different substituent of **X**, wherein **X** is t-butyl substituted alkylene vs. 2-bromo- or 2-methoxy-phenyl substituted alkylene. The two excluded compounds are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Also see MPEP§2173.05(i) under negative limitation. To overcome the rejection, applicants need to show the support in the original disclosure for such amendment.

Claim Objection

Claims 2-17, 19 and 30 are objected to for depending on rejected claim 1.

Conclusions

- Claim 18 is allowed.
- Claims 2-17, 19 and 30 are objected to.
- Claims 1-15, 17, 19 and 30 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/REI-TSANG SHIAO /

/Yong Chu/
Patent Examiner
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Rei-Tsang Shiao
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